

REMARKS

I. Status of Claims

Claims 1 and 8 are pending in the application.

Claim 1 is amended to use “consisting of” transitional language in describing the emulsifier. Claim 1 is further amended to recite that the amount of monoglycerin fatty acid, if used, is 2.5-3.0 parts by weight, with support in the present specification at, for example, Example 9-11.

No new matter is added, and a Request for Continued Examination is filed concurrently herewith. Applicants respectfully request entry and consideration of the Amendment.

II. Response to Claim Rejection Under 35 U.S.C. § 103(a)

Claims 1 and 8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Follmer (U.S. Patent No. 3,896,975) in view of Matsuda et al. (U.S. Patent No. 5,773,073).

Applicants respectfully submit that claims 1 and 8 are patentable over Follmer in view of Matsuda, at least for the following reasons.

Present claim 1 recites that the foamable water-in-oil type emulsifier consists of at least one member selected from the group consisting of monoglycerin fatty acid ester, sucrose fatty acid ester, sorbitan fatty acid ester, and polysorbate, and wherein the monoglycerin fatty acid ester is in the range 2.5-3.0 parts by weight based on the emulsion.

Follmer is drawn to a lecithin aqueous emulsion, which is used to uniformly coat hot and cold pan surfaces without foaming. In comparison, the present invention is drawn to a foamable emulsion. Moreover, the amount of mono- and di-glycerin fatty acid esters used in the composition

of Follmer is less than the presently claimed amount of mono-glycerin fatty acid ester. See, for example, Example 1 and claim 17 of Follmer.

At page 3 of the Office Action, the Examiner admits that Follmer does not teach or suggest the use of a specific emulsifier selected from the group consisting of glycerin fatty acid ester, sucrose fatty acid ester, sorbitan fatty acid ester and polysorbate. The Examiner relies on Matsuda to cure this deficiency in Follmer.

Matsuda is drawn to a water-in-oil emulsion having high water content and emulsion stability. Matsuda discloses polyglycerol esters of erucic acid as an emulsifier. At Table 2, Matsuda shows that polyglycerol fatty acid esters have enhanced efficacy over monoglycerol fatty acid esters. Compare Example a-c with Comparative Examples e and f. Table 2 further demonstrates that polyglycerol esters of erucic acid are essential to the invention of Matsuda. Compare Examples a-c with Comparative Examples a-e. Moreover, at column 3, lines 63-67, other edible emulsifiers, such as sucrose fatty acid ester, glycerol fatty acid ester, propylene glycol fatty acid ester, sorbitan fatty acid ester, and lecithin, can be used together with the emulsifier of Matsuda. Therefore, the emulsifier of Matsuda is a combination of a polyglycerol ester of erucic acid along with a secondary emulsifier. In fact, Table 2 of Matsuda also shows the improved properties of the emulsifier combination of Matsuda over emulsions using a single emulsifier that is not a glycerol ester of erucic acid. Therefore, Matsuda requires as an essential element polyglycerol ester of erucic acid, i.e., Matsuda teaches away from using the emulsifiers of the presently claimed water-in-oil type emulsion, which exclude polyglycerol esters of erucic acid.

Furthermore, the fact that the claimed composition omits the essential element of Matsuda and maintains the function of the essential element of Matsuda (because of other elements included in the claimed composition) is an indicia of unobviousness. *See* MPEP 2144.04 (“Note that the omission of an element and retention of its function is an indicia of unobviousness. *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966)”).

Follmer is drawn to a non-foamable composition, but the present application is drawn to a foamable composition. Moreover, there is no teaching or suggestion to combine the teachings of Matsuda and Follmer to replace the emulsifier of Follmer with one taught by Matsuda to reach the claimed foamable composition, because there is not teaching or suggestion in either Follmer or Matsuda, that combining the inventions of Follmer and Matsuda would result in a composition capable of forming a foam when discharged from the container.

In view of the above, claim 1 is patentable over the combination of Follmer and Matsuda. Claim 8 is also patentable, at least by virtue of its dependence from claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 1 and 8

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number **202-775-7588**.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
Application No.: 10/539,445

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Respectfully submitted,

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